APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,896	09/28/2001	Travis J. Parry	10012806-1	4357

7590 04/18/2007 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400	**EXAMINER** HANG, VU B

ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	09/966,896	PARRY, TRAVIS J.
	Examiner	Art Unit	
	Vu B. Hang	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 January 2007.*
2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-24* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *28 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *11/15/2005, 09/28/2001.*
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

- This office action is responsive to the following communication filed on 01/29/2007.

- Claims 1-24 are pending in the application.

Response to Arguments

1.   Applicant's arguments filed on 01/29/2007, with respect to the rejections of Claims 1-24

have been fully considered and are persuasive. Therefore, the previous rejections of Claims 1-24

have been withdrawn. However, upon further consideration, new ground(s) of rejection is made

in view of Van Der Linden et al. (US Patent 7,072,059 B2).

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 1-2, and 5-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Jecha et al. (US Patent 7,120,634 B2) in view of Van Der Linden et al. (US Patent 7,072,059

B2).

4.   Regarding **Claim 1**, Jecha discloses a method for sending a print job to a printer (see

Fig.3 and Col.1, Line 58-61), comprising: attaching at least one document to an e-mail message

(see Col.5, Line 59-64); sending the e-mail message over the network to an e-mail enabled

printer (see Fig.2 (204,206,216) and Col.5, Line 59-64); and extracting the at least one document

from the e-mail message by the e-mail enabled printer (see Col.5, Line 1-8). Jecha fails to

expressly disclose specifying instructions in a portion of the e-mail message for printing the at

last one document with the user selected printing attributes; and where the e-mail enabled printer

includes e-mail client software. Jecha, however, discloses creating documents to be sent to the e-

mail enabled printer for printing with user-selected options such as fonts, color and commands

(see Fig.3, Col.5, Line 35-40 and Col.5, Line 59 – Col.5, Line 2). Van Der Linden teaches

sending a print job from a client workstation to a remote printer via e-mail with user-selected

print options (see Col.1, Line 31-38 and Col.2, Line 26-30); and client software for

communicating print jobs to a printer over the Internet (see Col.6, Line 18-22 and Col.6, Line 58

– Col.7, Line 3).

Jecha and Vander Linden are combinable because they are from the same field of

endeavor, namely printing communication systems. At the time of the invention, it would have

been obvious for one skilled in the art to include a means for specifying instructions in a portion

of the e-mail message for printing the at last one document with the user selected printing

attributes. The motivation would be to communicate the specified print options to a remote

printer over the network. The user-selected printing attributes would allow for specifying exactly

how the documents are to be printed based on the user's preferences and requirements. It is

further the obvious to include an e-mail client software to the e-mail enabled printer. The

motivation would be to establish communication between the client workstation and a remote

printer over the Internet.

5.   Regarding **Claim 2, 17 and 22**, Jecha and Van Der Linden teaches the method as

described in Claim 1 but fail to disclose storing the at least one document in the job retention of

the e-mail enabled printer by the e-mail enabled printer. Van Der Linden, however, discloses

storing the documents to be printed in the print job retention at a print server (see Col.9, Line 36-

40), and teaches establishing a direct network connection with a specified address of a

reproduction center (Col.6, Line 58 – Col.7, Line 3). At the time of the invention, it would have

been obvious for one skilled in the art to include a means for storing the at least one document in

the job retention of the e-mail enabled printer by the e-mail enabled printer. The motivation

would be to send multiple print jobs directly to a particular e-mail enabled printer over the

network, without the processing from a server. The print job retention placed at the specified e-

mail enabled printer would allow for multiple print jobs to be stored at the printer.

6.   Regarding **Claim 5**, Jecha and Van Der Linden teaches the method as described in Claim

1 but fail to disclose printing the at least one document in conjunction with storing the at least

one document in the job retention of the e-mail enabled printer. Van Der Linden, however,

discloses storing the documents to be printed in the print job retention at a print server (see

Col.9, Line 36-40), and teaches establishing a direct network connection with a specified address

of a reproduction center (Col.6, Line 58 – Col.7, Line 3). At the time of the invention, it would

have been obvious for one skilled in the art to include a means for printing the at least one

document in conjunction with storing the at least one document in the job retention of the e-mail

enabled printer. The motivation would be to send multiple print jobs directly to a particular e-

mail enabled printer over the network, without the processing from a server. The print job

retention placed at the specified e-mail enabled printer would allow for multiple print jobs to be

stored at the printer.

7.   Regarding **Claim 6**, the rationale provided in the rejection of Claim 1 is incorporated

herein.

8.   Regarding **Claim 7**, the rationale provided in the rejection of Claim 1 is incorporated

herein.

9.   Regarding **Claim 8**, Van Der Linden further discloses specifying scheduling instructions

for scheduling the printing of the at least one document (see Col.9, Line 38-40 and Col.10, Line

8-14).

10.   Regarding **Claim 9**, Jecha further discloses providing printable readable language in the

portion of the e-mail message (see Col.2, Line 1-6 and Col.5, Line 59-64).

11.   Regarding **Claim 10**, Jecha further discloses encoding the printable readable language

prior to sending the e-mail over the network (see Col.2, Line 1-6 and Col.4, Line 57-64).

12.   Regarding **Claims 11 and 23**, Jecha further discloses encoding the printable readable

language in MIME encoding fields (see Col.2, Line 1-6 and Col.5, Line 59 – Col.6, Line 2).

13.   Regarding **Claim 12**, Jecha further discloses at the at least one document is attached to

the e-mail message in an application-specific format (see Col.5, Line 59-64).

14.   Regarding **Claims 13 and 16**, Jecha further discloses converting the application specific

format into a print ready file by an e-mail enabled printer (see Col.5, Line 4-8).

15.   Regarding **Claim 14**, Jecha further discloses wherein at least one document is attached to

the e-mail message in a bit-mapped image format (see Col.6, Line 31-40).

16.   Regarding **Claim 15**, Jecha discloses a method distributing a document for printing (see

Fig.3 and Col.1, Line 58-61), comprising: attaching at least one document to an e-mail message

(see Col.5, Line 59-64); sending the e-mail message over the network to an e-mail enabled

printer (see Fig.2 (204,206,216) and Col.5, Line 59-64); and sending the at least one document to

a network printer by the e-mail enabled print server (see Fig.2 and Col.4, Line 65 – Col.5, Line

8). Jecha fails to disclose attaching at a workstation the at least one document to an e-mail

message; specifying instructions in a portion of the e-mail message for printing the at least one

document with the user selected printing attributes; and extracting the at last one document at the

e-mail enabled print server.

Jecha, however, discloses creating documents to be sent to the e-mail enabled printer for

printing with user-selected options such as fonts, color and commands (see Fig.3, Col.5, Line 35-

40 and Col.5, Line 59 – Col.5, Line 2). Van Der Linden teaches sending a print job from a client

.workstation to an e-mail enabled print server via e-mail with user-selected print options (see

Fig.2 (42), Col.1, Line 31-38 and Col.2, Line 26-30); extracting the at last one document at the e-

mail enabled print server (see Col.8, Line 38-55); and the scheduling and routing of the print jobs

to a plurality of printers in the network (see Fig.4 (68,70) and Col.10, Line 8-22).

Jecha and Vander Linden are combinable because they are from the same field of

endeavor, namely printing communication systems. At the time of the invention, it would have

been obvious for one skilled in the art to include a means for specifying instructions in a portion

of the e-mail message for printing the at last one document with the user selected printing

attributes. The motivation would be to communicate the specified print options to a remote

· printer over the network. The user-selected printing attributes would allow for specifying exactly

how the documents are to be printed based on the user's preferences and requirements. It is

further obvious to include a means for extracting the at least one document at the e-mail enabled

print server. The motivation would be to provide scheduling and routing of the print jobs to the

appropriate printers in the network.

17.   Regarding **Claim 18**, Jecha further discloses printing the at least one document (see Fig.2

(204)).

18.   Regarding **Claim 19**, the rationale provided in the rejection of Claim 15 is incorporated

herein.

19.   Regarding **Claim 20**, Jecha further discloses the e-mail enabled print server converts the

document sent as print job into s print ready file (see Fig.2 (204,220) and Col.4, Line 51-64).

20.   Regarding **Claim 21**, the rationale provided in the rejection of Claim 1 is incorporated

herein.

21.   Regarding **Claim 24**, the rationale provided in the rejection of Claim 15 is incorporated

herein.

22.   Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jecha et al

(US Patent 7,120,634 B2) in view of Van Der Linden et al. (US Patent 7,072,059 B2), and in

further view of Maruyama (US Patent 7,016,057 B1).

23.   Regarding **Claim 3**, Jecha further teaches reading the instructions by the e-mail enabled

printer (see Col.4, Line 57- Col.5, Line 8), but Jecha and Van Der Linden fail to teach specifying

instructions for storing the at least one document in the job retention in a portion of the e-mail

message. Maruyama, however, discloses specifying instructions for storing the at least one

document in the job retention in a portion of the e-mail message (see Fig.12, Col.5, Line 12-17

and Col.9, Line 12-17).

Jecha, Van Der Linden and Maruyama are combinable because they are reform the same field of endeavor, namely printing communication systems. At the time of the invention, it would have been obvious for one skilled in the art to include specifying instructions for storing the at least one document in the job retention in a portion of the e-mail message. The motivation would be to instruct the printer to store a document in a particular format to be interpreted by the printer for printing.

24.   Regarding **Claim 4**, Maruyama further discloses reading the instructions for storing the at least one document by the e-mailed enabled printer (see Fig.2 (1e), Col.5, Line 12-17 and Col.9, Line 12-17).

Conclusion

25.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571) 272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vu Hang
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SUPERVISORY PATENT EXAMINER